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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 09/22/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,161

Applicant(s)

KENDRICK ET AL.

Examiner

Michael Pyzocha

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 2137

DETAILED ACTION

1. Claims 1-22 are pending.

Specification

2. The disclosure is objected to because of the following informalities: page 3 line 4 "uses" should be "used" and page 8 line 21 the phrase "provides a" is repeated.

Appropriate correction is required.

Claim Objections

3. Claims 1,14, and 17 are objected to because of the following informalities: "an Internet" should be "the Internet".

Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

Art Unit: 2137

States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Hobbs (U.S. 5,987,454).

As per claim 1, Hobbs discloses a data storage medium storing documents (see column 1 lines 40-44), accessible via the Internet (see column 12 lines 2-7), searchable access to the documents (see column 1 lines 44-54), a security system requiring a password (see column 1 lines 44-48) and encrypting the communications (see column 20 lines 1-8).

As per claim 2, Hobbs discloses the data storage medium being a database (see column 1 lines 40-44).

As per claim 4, Hobbs discloses different confidentiality levels restricting users from seeing unauthorized documents (see column 25 lines 51-55).

As per claim 7, Hobbs discloses a document management service where one computer is a management computer that controls access to the management service (see column 16 line 60 through column 17 lines 32 where the proxy server provides the access control).

Art Unit: 2137

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs as applied to claim 1 above, and further in view of Serbinis et al (U.S. 6,314,425).

Hobbs fails to claim the database comprising a RAID array.

However, Serbinis et al discloses the use of a RAID array in a database (see column 6 lines 27-34 where the DMS contains a database as described in column 5 lines 21-30).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to database system from Hobbs with the specific type of database from Serbinis et al.

Motivation to do so would be that using RAID arrays to implement the database would increase its reliability.

Art Unit: 2137

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs as applied to claim 4 above, and further in view of Ginter et al (U.S. 5,892,900).

Hobbs, fails to disclose the use of documents relating to litigation in the system.

However, Ginter et al discloses the use the litigation documents (see column 299 lines 13-33).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the system of Hobbs with the specific document type relating to litigation.

Motivation to do so would be to securely control access to client documents (see column 299 lines 13-33).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Hobbs and Ginter system as applied to claim 5 and 7 above, and further in view of Rackman (U.S. 5,903,646).

The modified Hobbs and Ginter system fails to disclose confidentiality levels being set forth in a court order governing discovery in the litigation.

However, Rackman discloses confidentiality levels being set from a court order (see column 2 lines 37-50).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the confidentiality

Art Unit: 2137

levels as described in Rackman with the modified system of Hobbs and Ginter.

Motivation to do so would have been to be able to change confidentiality levels based on a court order.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hobbs as applied to claim 7 above, and further in view of Rackman.

Hobbs fails to disclose one of the plurality of computers being a workstation for creating indexes of the documents.

However, Rackman discloses a workstation creating indexes of documents (see column 1 lines 29-59).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to apply the indexing of documents from Rackman to the system of Hobbs.

Motivation to do so would be to have the ability to display successive pages having a common trait (see Rackman column 1 lines 45-54).

11. Claims 9 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al, "Making of America - Online Searching and Page Presentation at the University of Michigan", D-Lib Magazine, 1997 (hereinafter Shaw) further in view of Ginter et al.

Art Unit: 2137

As per claim 9, Shaw discloses a process for accessing electronically stored documents via a website on the Internet (see first two paragraphs of page two), providing a search screen to search for terms contained in the documents, displaying the results comprising a list identifying the documents found to contain the search terms and providing links to the documents (see pages 4 through 7), providing an image of the document upon selection of a document from the list (see pages 7 through 9), the ability to switch views (see page 9), and the ability to print the document (since the document is displayed in a web browser the ability to print is an inherent quality of the browser).

Shaw fails to disclose the verification of the user viewing the documents, notes being related to the document, and the ability to add information to the notes.

However, Ginter et al discloses verifying the user accessing the website is entitled to access the documents (see column 299 lines 48-52), notes being related to the document, and being able to add information to these notes (see column 301 lines 29-41).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the verification

Art Unit: 2137

and ability to have notes from Ginter et al to the system of Shaw.

Motivation to do so would have been to securely control the access to the documents on the website (see Ginter et al column 299 lines 10-28).

As per claim 11, the modified Shaw and Ginter et al discloses allowing the user to magnify the image (see Shaw page 9)

As per claim 12, the modified Shaw and Ginter et al discloses the search comprising searching of OCR files corresponding to the images (see Shaw pages 3 and 4).

As per claim 13, the modified Shaw and Ginter et al discloses the prohibition of access to a portion of the documents when the use is not authorized (see Ginter et al column 299 lines 42-59).

As per claim 14, the modified Shaw and Ginter et al discloses a process of entering documents related to litigation (see Ginter et al column 299 lines 10-15), into a storage medium accessible via the Internet (see Shaw page 2), through the steps of scanning paper documents to create images on the storage medium (see Shaw page 2 paragraph 2), entering information related to the document into an index (see page 3 paragraph 1), performing OCR on the documents to create electronically

Art Unit: 2137

searchable files containing text shown in the documents (see Shaw pages 4 and 5), associating each image with an index and a searchable file (see Shaw page 4 paragraph 2), placing the images, index entries, and searchable files on a storage medium that is accessible to the users over the Internet (see Shaw page 5).

As per claim 15, the modified Shaw and Ginter et al discloses the entering step comprising entering objective information (see Shaw page 4).

As per claim 16, the modified Shaw and Ginter et al discloses the entering step comprising entering subjective information (see Ginter et al column 301 lines 29-41).

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Shaw and Ginter et al system as applied to claim 9 above, and further in view of "Making of America", webpage, 1999, Cornell University Library (hereinafter Cornell).

The modified Shaw and Ginter et al system fails to disclose the ability to rotate the images.

However, Cornell discloses the use of PDF files that are viewed in a PDF viewer all of which have the option to rotate the image (see Cornell printout).

Art Unit: 2137

At the time of the invention it would have been obvious to a person of ordinary skill in the art to apply the use of PDF files for rotation purposes to the modified Shaw and Ginter et al system.

Motivation to do so would have been to allow users to have more image viewing options (see Cornell printout).

13. Claims 17-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al (U.S. 6,148,333) further in view of Ginter et al.

As per claim 17, Guedalia et al discloses a process for producing documents from an electronic document storage facility accessible from remote locations via the Internet (see column 1 lines 21-23), comprising steps of determining which of the documents are to be produced (see column 9 lines 27-30), storing information identifying the document to be produced in a file (see column 9 lines 62-64), transferring the file to a document control system, selecting overlays, combining images of the document with the overlays to create an overlaid image and store the overlaid image on a memory device (see column 11 line 66 through column 12 line 44).

Guedalia et al fails to disclose the document type to be that of litigation.

Art Unit: 2137

However, Ginter et al discloses the use the litigation documents (see column 299 lines 13-33).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the overlaying system of Guedalia et al with the specific document type relating to litigation.

Motivation to do so would be to securely control access to client documents (see Ginter et al column 299 lines 13-33).

As per claim 18, the modified Guedalia et al and Ginter et al system discloses the information relating to the documents comprises file names of images of the documents to be produced (see Guedalia et al column 9 lines 62-64).

As per claim 21, the modified Guedalia et al and Ginter et al system discloses the overlays comprising a confidentiality level designation (see Guedalia et al column 12 lines 22-31).

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guedalia et al and Ginter et al as applied to claim 17 above, and further in view of Balogh et al (U.S. 5,493,677).

The modified Guedalia et al and Ginter et al system fails to disclose the use of a CD-ROM as the memory device.

However, Balogh et al discloses the use of CD-ROMs to store images (see column 1 lines 29-33).

Art Unit: 2137

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the modified system of Guedalia et al and Ginter et al with the memory source being a CD-ROM as described in Balogh et al.

Motivation to do so would have been to allow a customer to purchase a large number of images stored on one disc (see Balogh et al column 1 lines 29-33).

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Guedalia et al and Ginter et al system as applied to claim 17 above, and further in view of Ryan Jr. (U.S. 4,241,994).

The modified Guedalia et al and Ginter et al system fails to disclose the use of paper as the memory device.

However Ryan Jr. discloses the use of overlaid images on paper (see column 1 lines 22-31).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to store the overlaid images, of the modified Guedalia et al and Ginter et al, on paper as described in Ryan Jr.

Motivation to do so would have been to allow for many copies to be made by a copy machine (see Ryan Jr. column 1 lines 22-31).

Art Unit: 2137

16. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Guedalia et al and Ginter et al system as applied to claim 17 above, and further in view of Parks et al (U.S. 5,025,396).

The modified Guedalia et al and Ginter et al system fails to disclose the overlays comprising a unique identification code to identify each page of the documents.

However, Parks et al discloses the use of unique identification codes being overlaid onto images (see column 1 line 58 through column 2 line 9).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to apply the unique identification code as an overlaid image to the modified system of Guedalia et al and Ginter et al.

Motivation to do so would have been to allow the retrieval of the images without the user knowing the internal data structure characteristics (see Parks et al column 3 lines 53-64).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kenyon (U.S. 6,199,065) discloses a secure system to remotely access a database. Wong et al (U.S. 6,745,332) discloses a method and

Art Unit: 2137

apparatus for enabling privileges in a database. Lamping et al (U.S. 6,324,551) discloses storing and searching based on user-defined properties. Bowman-Amuah (U.S. 6,289,382) discloses a system of distributing services globally based on user privileges.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (703) 305-0712. The examiner can normally be reached from 7:30am - 5:00pm with first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (703) 306-3036. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

Andrew Caldwell
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